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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,265	01/20/2000	Lehmann Martin	5808.200-US	4209

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EXAMINER

RAMIREZ, DELIA M

ART UNIT PAPER NUMBER

1652

DATE MAILED: 07/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488,265

Applicant(s)

MARTIN, LEHMANN

Examiner

Delia M. Ramirez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 18 and 24 is/are rejected.
- 7) ☒ Claim(s) 17-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Application***

Claims 15-26 are pending.

Applicant's cancellation of claims 1-15 and addition of claims 15-26 in Paper No. 18, filed on 4/30/2002 are acknowledged.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### ***Inventorship***

1. In view of the papers filed 11/20/200, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding inventor Soren Flensted Lassen.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

### ***Drawings***

2. The drawings have been reviewed and are approved by a draftsman under 37 CFR 1.84 or 1.152.

***Claim Objections***

3. Claims 17-20 objected to because of the following informalities: for clarity, it is suggested that the term "an amino acid sequence" be replaced with "the amino acid sequence".

Appropriate correction is required.

4. Claims 21-26 are objected to because of the following informalities: for clarity, it is suggested that the term "a phytases of claim #" be replaced with "the phytase of claim #".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, Second Paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 15-16 are indefinite in the recitation of "wherein % identity is determined by GAP provided in the GCG program package" as it is unclear absent a statement indicating the parameters used to calculate % identity. It is suggested that the claims be amended to include a length weight of 0 and a gap weight of 3 for amino acid sequences (page 15, lines 6-9) and a gap creation penalty of 50 and a gap extension penalty of 3 for nucleic acid sequences (page 15, lines 15-17). Correction is required.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 18 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-5, 37-38, 40-42 of copending Application No. 09/343,126. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 18 and 24 of the instant application are drawn to a phytase labeled consensus phytase 10 thermo 3 Q50T-K91A ( SEQ ID NO: 30/31) and claims 4-5, 37-38, 40-42 are directed to a composition comprising a phytase labeled consensus phytase 10 thermo Q50T-K91A. Since the specification discloses several consensus phytase 10 thermo #, it is assumed that the phytase of copending Application No. 09/343,126 includes all thermo # variants including thermo 3, which is that of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. It is noted that SEQ ID NO: 167 of copending Application No. 09/343,126 is 94.9% sequence identical to SEQ ID NO: 26, which Applicant's specification discloses as that of a

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consensus phytase 10. It has been assumed that SEQ ID NO: 167 is not being claimed in copending Application No. 09/343,126. If, however, it is later established that SEQ ID NO: 167 is being claimed in copending Application No. 09/343,126, claims directed to the polypeptide of SEQ ID NO: 26 and/or the polypeptide encoded by the polynucleotide of SEQ ID NO: 25 (claims 15-16, 21-22) will be rejected under the judicially created doctrine of obviousness-type double patenting.

11. It is noted that the molecules of SEQ ID NO: 25, 26, 27, 28, 29, 30 or 31 have been disclosed in Applicant's copending Application No. 09/684,855 or 09/273871. Since these applications are not available to the examiner at this time, no determination has been made as to whether or not a double patenting rejection should be applied to the claims of the instant application. If, upon availability of the above application to the examiner, it is determined that there are conflicting claims between application Serial No. 09/684,855 or 09/273871 and the instant application, double patenting will not be considered as new ground(s) of rejection.

### ***Conclusion***

12. No claim is in condition for allowance.

13. Applicants are requested to submit a clean copy of the pending claims (including amendments, if any) in future written communications to aid in the examination of this application.

14. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94

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(December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

DR  
July 8, 2002

Delia M. Ramirez, Ph.D.  
Patent Examiner  
Art Unit 1652



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